## REMARKS

The Official Action mailed December 18, 2001 and the Advisory Action mailed June 4, 2002 have been received and their contents carefully noted. Filed concurrently herewith is a *Request for Continued Examination (RCE)* and *Request for Three Month Extension of Time,* which extends the shortened statutory period for response to June 18, 2002. Accordingly, Applicant respectfully submits that this response is being timely filed.

Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on December 27, 2000 and July 3, 2001.

Claims 109-132 were pending in the present application. New claims 133-136 have been added to clarify the position of the switching device and DLC film. New claims 137-140 have been added to recite that the first insulating layer comprising an organic resin provides a flattened surface. Claims 109-140 are now pending in the present application, of which claims 109, 113, 117, 121, 125, 133 and 137 are independent.

With the submission of the English translation of priority Japanese application 9-092935, the rejections based on Hamada are overcome as indicated in the Advisory Action. Thus, the rejections set forth in paragraph 1 of the Official Action have been overcome.

Paragraph 2 of the Official Action rejects claims 109-116 and 121-128 as obvious based on the combination of U.S. Patent 5,550,066 to Tang et al. and U.S. Patent 5,117,299 to Kondo et al. As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary

skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Tang discloses an electroluminescence display comprising a thin film transistor (T1), a first insulating layer (42), a second insulating layer (52), a pixel electrode (ITO), and a light-emitting layer (82) in Fig. 3. Kondo discloses a hard carbon film as an insulating layer used in a MIM device (column 4, lines 9-10). The MIM device of Kondo appears to correspond to the thin film transistor (T1) of Tang because both the TFT and the MIM device are used as a switching device (Kondo, column 1, lines 9-11). Also, the hard carbon film of Kondo appears to correspond to the first insulating layer (42) of Tang because the hard carbon film is used in a MIM device. That is, the insulating layer comprising DLC of the present invention is provided in addition to the switching device, while the hard carbon film of Kondo is provided as a part of the switching device. Even if Kondo and Tang are combined and the hard carbon film of Kondo is applied to the electroluminescence display of Tang, it appears that the combination of Tang and Kondo would not suggest an insulating film comprising DLC provided in addition to a thin film transistor. Therefore, it is respectfully submitted that the combination of Tang and Kondo fails to teach or suggest every limitation recited in the currently pending claims and that a *prima facie* case of obviousness cannot be maintained. That is, there is no teaching or suggestion of an insulating film comprising DLC provided in addition to a thin film transistor.

Furthermore, it is respectfully submitted that there has been an insufficient showing of any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings to achieve the present invention. Since the hard carbon film of Kondo appears to correspond to the first insulating layer 42 of Tang, it is submitted that one of ordinary skill in the art would have at best been motivated to

replace the layer 42 of Tang with the hard carbon film of Kondo and would not have been motivated to provide an additional DLC film as recited in the present application.

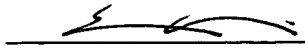
In addition, although rejected claims 113 and 125 recite an insulating layer comprising silicon nitride, the silicon nitride layer is not disclosed or suggested in either Tang or Kondo, alone or in combination.

For the above reasons, the rejection of claims 106-116 and 121-128 is believed to be improper and favorable reconsideration is respectfully requested in view of the above remarks.

Paragraphs 3 and 4 of the Official Action rejects claims 109-132 under the doctrine of obviousness-type double patenting as being unpatentable over claims 90-91 and 97 of U.S. Patent 6,115,090. However, it appears that claims 90-91 and 97 of U.S. Patent 6,115,090 do not disclose the composition of the light-emitting layer and the DLC film. Furthermore, there is no teaching or suggestion to one of ordinary skill in the art to modify the disclosure of claims 90-91 and 97 of the '090 patent to achieve these features of the present invention. It is respectfully submitted that absent such disclosure or suggestion, a rejection under the doctrine of obviousness-type double patenting cannot be maintained. Reconsideration is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789